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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/798,311

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EXAMINER

FISHER, PAUL R

ART UNIT

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3689

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09/30/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/798,311	Applicant(s) BLUM ET AL.	
	Examiner PAUL R. FISHER	Art Unit 3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-20,28,29,31-34,36 and 37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-20,28,29,31-34,36 and 37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 June 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Amendment submitted on June 20, 2008 has been acknowledged. Claims 3, 8 21-27, 30 and 35 have been cancelled. Claims 1, 2, 4-20, 28, 29, 31-34, 36 and 37 are currently pending and have been considered below.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 28, 29, 31, 32, and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Joao (US2002/0016655A1).**

As per claim 28, Joao discloses a data center used in a remote evaluation of a vehicular part (Figure 1; discloses a central processing computer or server which takes in data from various other locations for the evaluation of vehicle parts), said data center comprising:

a computer server adapted to communicate with a vehicular dealer and an assessment center (Figure 1; discloses that the central processing computer or server communicates with other computers across the network, this would include the first location and the second location that could be any of the computers connected to the network), said computer server comprising:

input means for receiving, from said vehicular dealer, said electronic folder including said description information regarding said condition of said vehicular part in an electronic folder (Page 21, paragraph 283; discloses that the user enters information that is to be sent to the central server via a computer. Page 12, paragraph 173; discloses various input devices to enter information into the system);

output means for sending said description information to said assessment center (Page 15, paragraph 213; discloses output devices the could be used by the system); and

said input means for further receiving, from said assessment center, an assessment based on said description information, said electronic folder being modified at said assessment center to include said assessment (Page 22, paragraph 293; discloses the user being sent the report or assessment. Page 12, paragraph 173; discloses various input devices to enter information into the system).

The fact that the device is being used during a recycling process adds no further structural limitations to the claim and is thus is given little patentable weight.

As per claim 29, Joao discloses the above-enclosed invention; Joao further discloses wherein said description information comprises at least one of textual data, binary data, scanned documents, digital images, digital audio and video of said vehicular parts (Page 21, paragraph 286, Page 12, paragraph 177, Page13, paragraph 185).

As per claim 31, Joao discloses the above-enclosed invention, Joao further discloses comprising a server database for storing at least a portion of said description information in said electronic folder (Page 15, paragraph 206; discloses that the system includes a database that will be used to store all of the information).

As per claim 32, Joao discloses the above-enclosed invention, Joao further discloses wherein said computer server is further adapted to communicate with a third location and said output means further sends said assessment to said third location (Page 22, paragraph 299; discloses that various parties can access the system, and these parties include intermediaries, these parties can obtain information and input information).

As per claim 36, Joao discloses the above-enclosed invention, Joao further comprising a server database for storing at least a portion of said description information in said electronic folder (Page 15, paragraph 206; discloses that the system includes a database that will be used to store all of the information).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1, 2, 4-7, and 9-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joao (US2002/0016655A1), in view of Amir M. Hormozi: "Parts**

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Remanufacturing in the Automotive Industry” (First Quarter 1997) hereafter Hormozi.

As per claim 1, Joao discloses a method for remotely evaluating a condition of a vehicular part (Page 1, paragraph 9; discloses that the invention pertains to vehicle maintenance, and that information is shared. Page 2, paragraph 15; discloses that there is a central point in which the different parties communicate through and that one of the parties are vehicle parts providers) comprising:

obtaining, from a vehicular dealer, description information regarding said condition of said vehicular part in an electronic folder (Page 21, paragraph 281; discloses that the information is gathered about state of disrepair, further it states that this information can be obtained from a vehicular dealer);

sending, from a central server, said electronic folder including said description information to an assessment center (Page 22, paragraph 293; discloses that the central processing computer or central server transmits or sends the diagnostic report and/or repair, maintenance, and/or servicing report to the user's computer, Page 21, paragraph 282; discloses that a user can consist in any number of people including vehicle service providers and vehicle insurance providers which are equivalent to an assessment center, from this it is shown that a central server sends an electronic folder including description information to an assessment center);

receiving, in the central server, from said assessment center, an assessment based on said description information, said electronic folder being modified at said assessment center to include said assessment (Page 22, paragraph 297; discloses that

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the service provider or repair facility which is considered the assessment center can transmit back to the central server updated or modified information including the assessment of the vehicle and or part); and

Joao fails to fully disclose determining whether said vehicular part may be recycled based on said assessment.

Hormozi, which talks about parts remanufacturing in the automotive industry, teaches determining whether said vehicular part may be recycled based on said assessment (Page 26, paragraphs 1 and 2; teach that there are different strategies in saving customers money and address the concerns of different constituencies, some of them include recycling and remanufacturing).

From this teaching of Hormozi, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the part servicing system provided by Joao, with the use of recycling taught by Hormozi, to accomplish the required services for the customer for less. As mentioned in Hormozi many dealers or manufacturers don't have the resources to take on such a task as repairing parts or recycling them and often these parts were just replaced with brand new ones. Hormozi shows that the process of disposing of parts that could be salvaged is wasteful and also costs more money and energy then having those parts repaired or recycled.

As per claim 2, Joao discloses the above-enclosed invention; Joao further discloses wherein said description information comprises at least one of textual data, binary data, scanned documents, digital images, digital audio and video of said

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vehicular parts (Page 21, paragraph 286, Page 12, paragraph 177, Page13, paragraph 185).

As per claim 4, Joao discloses the above-enclosed invention, Joao further discloses comprising at least one of the steps of mining data and generating reports for a plurality of vehicular parts and their assessment (Page 22, paragraph 289; discloses that the reports will include whatever plurality of parts will be necessary to affect the repairs).

As per claim 5, Joao discloses the above-enclosed invention, Joao further discloses wherein said data and reports are compatible with internal data management systems of a party receiving said data and reports (Page 22, paragraph 299; discloses that any of the users of the system can access and use the information that is stored on the central server which is acting as the internal data management system, since all parties can access and add information all of that information has to be compatible).

As per claim 6, Joao discloses the above-enclosed invention, Joao further discloses that warranty information is handled by the system and that the payment information would also be handled by the system (Page 22, paragraph 290; discloses that information will be sent to the warranty providers and that this information will effect who is responsible for paying for the repair).

Joao fails to explicitly disclose wherein said determining whether said vehicular part may be recycled comprises determining at least one of a disposition and a warranty settlement for said vehicular part based on said assessment.

While Joao fails to fully disclose the idea of a settlement, it would have been obvious to one of ordinary skill in the art at the time of the invention include a settlement during the process of determining who is responsible for paying for the repairs. For example if the user's engine seizes during normal operation they would call up the warranty provider to determine if the damage was covered by their warranty. At which point the warranty provider would issue a disposition or final judgment if the user is to be awarded a settlement and the damage is covered by the user's warranty.

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include settlements being awarded to the user of the vehicle provided by Joao, for the purpose of ensuring that the user gets compensated for their damage to their vehicle, if it is covered by the warranty.

As per claim 7, Joao discloses the above-enclosed invention; Joao further discloses wherein said description information comprises at least one of textual data, binary data, scanned documents, digital images, digital audio and video of said vehicular parts (Page 21, paragraph 286, Page 12, paragraph 177, Page13, paragraph 185).

As per claim 9, Joao discloses the above-enclosed invention, Joao further discloses comprising at least one of the steps of mining data and generating reports for a plurality of vehicular parts and their assessment (Page 22, paragraph 289; discloses that the reports will include whatever plurality of parts will be necessary to affect the repairs).

As per claim 10, Joao discloses the above-enclosed invention, Joao further discloses wherein said data and reports are in such a format as to be compatible with internal data management systems of a party receiving said data and reports (Page 22, paragraph 299; discloses that any of the users of the system can access and use the information that is stored on the central server which is acting as the internal data management system, since all parties can access and add information all of that information has to be compatible).

As per claim 11, Joao discloses the above-enclosed invention, Joao further discloses that the system is used to facilitate the process of repairing parts or performing services associated with those parts (Page 22, paragraph 290; discloses the central server takes in information that will help in the repair process for parts and services). Joao also discloses that many facilities can access the system (Page 22, paragraph 299; discloses that multiple parties can access the system in regard to repair and servicing of parts, these parties include intermediary or third party sites).

Joao fails to explicitly disclose sending said vehicular part to a third party for at least one of repair and recycling.

Hormozi, which talks about remanufacturing parts in the automotive industry, teaches sending vehicular parts to a third party and that services provided by the third party include repair and recycling (Page 26, paragraphs 2 and 6; teach that there are five services that can be performed two of which are repair and recycling, and that 90% of sales come from independent channels such as third parties. Page 26, paragraph 8; teaches that companies like Ford motor company have often relied on third party sites

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to repair and remanufacture items since they did not have the resources, from this it would be obvious that in the case of repair and recycling of parts third parties would be used if the facilities such as the dealer does not have the resources on site to complete the task. Also it would have been obvious that since these third party sites are not located on site they would have to have the parts sent to them).

From this teaching of Hormozi, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the part servicing system provided by Joao, with the use of sending third parties parts for repair or recycling taught by Hormozi, to accomplish the required services for the customer. As mentioned in Hormozi many dealers or manufacturers don't have the resources to take on such a task as repairing parts or recycling them and often these parts were just replaced with brand new ones. Hormozi shows that the process of disposing of parts that could be salvaged is wasteful and also costs more money and energy then having those parts repaired or recycled. Since the system is dealing with third parties or companies that are not onsite the parts that have to be services would have to be sent to them in order for them to be repaired or recycled.

As per claim 12, The combination Joao and Hormozi teaches the above-enclosed invention, Joao further discloses providing an assessment detail based on vehicular parts (Page 22, paragraph 289; discloses that the different services providers can provide a diagnosis or an assessment regarding the state of disrepair of the part).

Joao fails to explicitly disclose comprising at least one of identifying and ordering missing materials required for a remanufacturing of said vehicular part based on said assessment details.

Hormozi, which talks about remanufacturing parts in the automotive industry, teaches comprising at least one of identifying and ordering missing materials required for remanufacturing of said vehicular part based on said assessment details (Page 29, paragraphs 5 and 6 under Bills of Materials; teaches that each remanufactured parts have pieces associated with them that have to be identified, ordered and then replaced).

As per claim 13, the combination Joao and Hormozi teaches the above-enclosed invention; Joao fails to fully disclose comprising the automatically ordering said materials required for remanufacturing of said vehicular part.

Hormozi, which talks about remanufacturing parts in the automotive industry, teaches comprising the automated ordering of said materials required for remanufacturing of said vehicular part (Page 29, paragraphs 5 and 6 under Bills of Materials; teaches that each remanufactured parts have pieces associated with them that have to be identified, ordered and then replaced and that these pieces are ordered automatically if it is guaranteed that those parts will be replaced, as stated with a RF rating of 1.00, which states that every time the person in going to remanufacture that part, that piece is going to have to be replaced every time).

As per claim 14, Joao discloses the above-enclosed invention, Joao further discloses that original equipment manufacturers have intermediaries or third parties

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handle things (Page 2, paragraph 21; discloses that intermediaries can act on behalf of the vehicle manufacturers which are the OEM or original equipment manufacturers.

Page 22, paragraph 299; discloses that these intermediaries can access the system at any time. Page 21, paragraph 281; discloses that the first location can be the vehicle manufacturer and/or intermediaries).

Joao fails to explicitly disclose where the representative or intermediary is authorized.

Hormozi, which talks about remanufacturing parts in the automotive industry, teaches that representatives of the original equipment manufacturer are authorized (Page 26, paragraph 8; teaches that Ford used outside companies as intermediaries for the exchange of parts and services and those intermediaries were authorized representatives).

From this teaching of Hormozi, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the part servicing system provided by Joao, with the use of authorized intermediaries or third parties taught by Hormozi, for the purpose of ensuring the quality of work to their customers. If the third party did not have a high standard of work it would reflect poorly upon the original equipment manufacturer so by authorizing these companies shows the customer that these facilities are up to par with the original equipment manufacturer. Also as stated in the article this deal benefits the OEM because in some cases these they don't have the infrastructure or the resources to take on such a service so these third parties offer a reliable alternative.

As per claim 15, Joao discloses the above-enclosed invention, Joao further discloses wherein assessment center comprises at least one of an independent assessing center, an original equipment manufacturer, and a warranty processing center (Page 22, paragraph 290; discloses that the assessment can be any one of an independent assessing center or repair shop, equipment manufacturers, warranty providers as well as others).

As per claim 16, Joao discloses the above-enclosed invention, Joao further discloses comprising the step of providing access to a party at a third location to said assessment details (Page 22, paragraph 299; discloses that access is granted to multiple parties at any point and those parties include intermediaries or third parties. These parties can access the system to view the assessment and to add information).

As per claim 17, Joao discloses the above-enclosed invention, Joao further discloses wherein said party at said third location accesses said assessment details through an Internet web browser (Page 11, paragraph 168; discloses that the invention functions on the Internet and can be accessed using a web site which accessing would have to include the use of a web browser).

As per claim 18, Joao discloses the above-enclosed invention, Joao further discloses wherein said party at said third location comprises an original equipment manufacturer (Page 22, paragraph 299; discloses that at any time another party can access the system which includes the vehicle manufacture or the original equipment manufacturer).

As per claim 19, Joao discloses the above-enclosed invention, Joao further discloses comprising the step of producing data and reports for a plurality of vehicular parts and their assessment (Page 22, paragraph 289; discloses that the reports will include whatever plurality of parts will be necessary to affect the repairs).

As per claim 20, Joao discloses the above-enclosed invention, Joao further discloses comprising the step of providing said data and reports in such a format as to be compatible with internal data management systems of a party receiving said data and reports (Page 22, paragraph 299; discloses that any of the users of the system can access and use the information that is stored on the central server which is acting as the internal data management system, since all parties can access and add information all of that information has to be compatible).

6. **Claims 33, 34, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joao (US2002/0016655A1).**

As per claim 33, Joao discloses the above-enclosed invention, Joao further discloses that warranty information is handled by the system and that the payment information would also be handled by the system (Page 22, paragraph 290; discloses that information will be sent to the warranty providers and that this information will effect who is responsible for paying for the repair).

Joao fails to explicitly disclose wherein the computer server is adapted to determine at least one of a disposition and a warranty settlement for said vehicular part based on said assessment.

While Joao fails to fully disclose the idea of a settlement, it would have been obvious to one of ordinary skill in the art at the time of the invention include a settlement during the process of determining who is responsible for paying for the repairs. For example if the user's engine seizes during normal operation they would call up the warranty provider to determine if the damage was covered by their warranty. At which point the warranty provider would issue a disposition or final judgment if the user is to be awarded a settlement and the damage is covered by the user's warranty.

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include settlements being awarded to the user of the vehicle provided by Joao, for the purpose of ensuring that the user gets compensated for their damage to their vehicle, if it is covered by the warranty.

As per claim 34, Joao discloses the above-enclosed invention; Joao further discloses wherein said description information comprises at least one of textual data, binary data, scanned documents, digital images, digital audio and video of said vehicular parts (Page 21, paragraph 286, Page 12, paragraph 177, Page13, paragraph 185).

As per claim 37, Joao discloses the above-enclosed invention, Joao further discloses wherein said computer server is further adapted to communicate with a third location and said output means further sends said assessment to said third location (Page 22, paragraph 299; discloses that various parties can access the system, and these parties include intermediaries, these parties can obtain information and input information).

Response to Arguments

7. Applicant's arguments filed June 20, 2008 have been fully considered but they are not persuasive.

8. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

9. In regards to the applicant's argument that "The assessment is not the same as the description information", the Examiner respectfully disagrees. The descriptive information stated in Joao discloses that it performs a diagnosis of a vehicle problem, malfunction, and/or state of disrepair. So the description information is a description of the problem which is equivalent to an assessment of the problem since assessment is defined as the act of assessing which is the act of assess which is defined by Merriam-Webster (<http://www.merriam-webster.com/dictionary/assessing>) as to determine the importance, size, or value of <assess a problem>. The applicant has provided no information to show this equivalence to be wrong, but rather has merely stated that it is.

10. All rejections made towards the dependent claims are maintained due to the lack of a reply by the applicant in regards to distinctly and specifically point out the supposed errors in the examiner's action in the prior Office Action (37 CFR 1.111). The Examiner asserts that the applicant only argues that the dependent claims should be allowable because the independent claims are unobvious and unpatentable over Joao and Hormozi where applicable.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL R. FISHER whose telephone number is (571)270-5097. The examiner can normally be reached on Mon/Fri [7:30am/5pm] with first Fri off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on (571)272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PRF

/Janice A. Mooneyham/
Supervisory Patent Examiner, Art Unit 3689